REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 1-4 have been amended to recite that the dye J-aggregate is water-dispersible. Support for such amendments can be found in the instant specification at least at page 40, lines 1-3.

In the Official Action, claims 1 and 5-11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,184,268 *(Nichols et al)* in view of either U.S. Patent No. 6,136,079 (*Evans et al*) or U.S. Patent No. 6,093,510 (*Helber et al*). Claims 2, 3 and 12 stand rejected under 35 U.S.C. §103(a) as being obvious over *Nichols et al* in view of U.S. Patent No. 5,302,437 (*Idei et al*), and either *Evans et al* or *Helber et al.*

Claims 1, 5 and 9-11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,313,196 (*Helling et al*) in view of either *Evans et al* or *Helber et al.* Claims 2, 3 and 12 stand rejected under 35 U.S.C. §103(a) as being obvious over *Helling et al* in view of *Idei et al* and either *Evans et al* or *Helber et al.* Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over *Nichols et al* or *Helling et al* in view of U.S. Patent No. 4,832,984 (*Hasegawa et al*) and either *Evans et al* or *Helber et al.* Withdrawal of the above rejections is respectfully requested for at least the following reasons.

Nichols et al and *Helling et al* do not disclose or suggest each feature of aspects of the present invention as defined by claims 1-4. For example, as acknowledged by the Patent Office,

Nichols et al and *Helling et al* do not disclose or suggest a dye J-aggregate, let alone a dye J-aggregate that is water-dispersible, as is now recited in claims 1-4.

In this regard, the Patent Office has relied on *Evans et al* for disclosing a dye J-aggregate. However, like *Nichols et al* and *Helling et al*, *Evans et al* does not disclose or suggest a dye J-aggregate that is water-dispersible, as recited in claims 1-4. By comparison, *Evans et al* discloses a monomethine oxonol dye that is water-soluble (col. 2, lines 21-24). *Evans et al* simply has no disclosure or suggestion of a dye J-aggregate that is water-dispersible.

The Patent Office has relied on *Helber et al* for disclosing a dye J-aggregate, and has suggested modifying the ink of *Nichols et al* or *Helling et al* by incorporating the *Helber et al* dye therein. The Patent Office has asserted that one of ordinary skill in the art would have been motivated to make such modification in light of *Helber et al* at column 16, lines 62 and 63, which mentions the use of an oxonol dye "in non-photographic imaging applications such as inkjet, barcoding, and thermally-developed imaging systems."

It is well established that the Patent Office bears the burden of showing that there is some suggestion or motivation to modify a reference or to combine reference teachings. In this regard, M.P.E.P. §2143.01 states that "[t]he prior art must suggest the desirability of the claimed invention. [emphasis added]" The M.P.E.P. further states that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness."

While the Patent Office has asserted that *Helber et al* can be used in an inkjet system, it has not been shown that the prior art suggests the desirability of modifying the ink of *Nichols et al* or *Helling et al* to arrive at the claimed invention. For example, no evidence or scientific reasoning has been provided which shows that one of ordinary skill in the art would have

expected the alleged modification to result in some advantage or benefit in the ink jet inks of *Nichols et al* or *Helling et al*. In the present case, the Patent Office has asserted that the *Helber et al* dye can be used in an inkjet system. However, as discussed above, the fact that an alleged modification "can be" accomplished is insufficient for supporting a *prima facie* case of obviousness.

For at least the reasons discussed above, it is apparent that one of ordinary skill in the art would not have been motivated to modify the ink of *Nichols et al* or *Helling et al* by incorporating the *Helber et al* dye therein.

Idei et al and *Hasegawa et al* fail to cure the above-described deficiency of *Nichols et al* and *Helling et al*. In this regard, like *Nichols et al* and *Helling et al*, *Idei et al* and *Hasegawa et al* do not disclose or suggest a dye J-aggregate that is water-dispersible, as recited in claims 1-4.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the above §103(a) rejections is respectfully requested.

Claims 1 and 5-11 stand rejected under 35 U.S.C. §103(a) as being obvious over *Nichols et al* in view of U.S. Patent Application Publication No. 2002/0046680 (*Noro et al*). Claims 2, 3 and 12 stand rejected under 35 U.S.C. §103(a) as being obvious over *Nichols et al* in view of *Idei et al* and *Noro et al*. Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over *Nichols et al* in view of *Hasegawa et al* and *Noro et al*.

Without addressing the propriety of the above rejections, submitted herewith is a Statement Under 35 U.S.C. §103(c), which states that *Noro et al* and the claimed invention were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the same entity. As such, under the provisions of 35 U.S.C. §103(c), *Noro et al* is removed

from qualifying as §102(e) prior art in the above §103(a) rejections. Accordingly, withdrawal of the above §103(a) rejections is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____
Roger H. Lee
Registration No. 46,317

P.O. Box 1404
Alexandria, VA 22313-1404
(703) 836-6620

Date: March 1, 2004